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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,945	02/24/2004	James L. Tracy	CE12442JME	3815

24273 7590 06/02/2006

MOTOROLA, INC  
INTELLECTUAL PROPERTY SECTION  
LAW DEPT  
8000 WEST SUNRISE BLVD  
FT LAUDERDAL, FL 33322

EXAMINER

VUONG, QUOCHIE B

ART UNIT	PAPER NUMBER
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2618

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/786,945	Applicant(s) TRACY ET AL.	
	Examiner Quochien B. Vuong	Art Unit 2618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

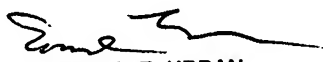
1. In view of the appeal brief filed on 03/17/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
EDWARD F. URBAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

This action in response to appeal brief filed on 03/17/2006. Claims 1-20 are now pending in the present application. **This action is made non-final.**

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-12, 14-18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nickum (US 6,760,600).

Regarding claim 1, Nickum (figures 1 and 2) discloses an electronic product, comprising: an electronic host device (portable computer 12); and at least one peripheral device (cellular telephone 14, or pager 16) that selectively couples and decouples to the electronic host device and activates independently of the electronic host device when decoupled from the electronic host device and further activates and operates independently of other peripheral devices that selectively couple and decouple to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 2, Nikum discloses the electronic device further inherently comprises a means for wearing the electronic product on at least one among the electronic host device and the at least one peripheral device on a user (since they are portable computer, cellular phone, and pager) (column 3, lines 19-34).

Regarding claim 3, Nikum discloses wherein the at least peripheral device (cellular phone 14 or pager 16) activates automatically upon being decoupled from the electronic host device (portable computer 12) (column 3, line 19 – column 5, line 13).

Regarding claim 4, Nikum discloses the at least one peripheral device activates independently of any other peripheral device for the electronic host device (since they are different units including cellular phone and pager) (column 3, line 19 – column 5, line 13).

As to claim 5, Nikum discloses a peripheral device (cellular phone 14 or pager 16) automatically senses the need for its own power source to become active when selectively decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 7, Nikum discloses the at least one peripheral device can be selected among the group of peripherals comprising an earpiece, a display, a microphone, a user interface, a keyboard, a phone, a pager, a personal digital assistant, a camera, a watch, a computer, a receiver, and a transmitter (see figures 1 and 2).

Regarding claim 8, Nikum discloses any combination of peripheral devices operates concurrently and independently with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 9, Nikum (figures 1 and 2) discloses an electronic host device (portable computer 12) forming a portion of an electronic product, comprising: a power source; at least one port for receiving at least two peripheral devices (cellular phone 14 and pager 16) that independently and selectively couple and decouple to the electronic

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host device and activate independently of the electronic host device and other peripheral devices when decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 10, Nikum (figures 1 and 2) discloses a peripheral device (cellular phone 14 or pager 16) forming a portion of an electronic product, comprising: a power source; a port for coupling with at least one electronic host device (portable computer 12), wherein the peripheral device selectively couple and decouple to the at least one electronic host device and activates independently of the electronic host device when decoupled from the electronic host device and other peripheral devices that work in conjunction with the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 11, Nikum discloses wherein the peripheral device (cellular phone 14 or pager 16) activates automatically upon being decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

As to claim 12, Nikum discloses a peripheral device (cellular phone 14 or pager 16) automatically senses the need for its own power source to become active when selectively decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 14, Nikum disclose sthe at least one peripheral device can be selected among the group of peripherals comprising an earpiece, a display, a microphone, a user interface, a keyboard, a phone, a pager, a personal digital assistant, a camera, a watch, a computer, a receiver, and a transmitter (see figures 1 and 2).

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Regarding claim 15, Nikum discloses any combination of peripheral devices operates concurrently and independently with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

Regarding claim 16, Nikum (figures 1 and 2) discloses a method of operating at least one peripheral device (cellular phone 14 or pager 16) independently from an electronic host device (portable computer 12), comprising the steps of: powering the electronic host device and the at least one peripheral device using a power source for the electronic host device when the at least one peripheral device is coupled to the electronic host device; detecting a selective decoupling of the at least one peripheral device from the electronic host device; powering the electronic host device using the power source for the electronic host device and independently powering the at least peripheral device with a power source for the at least one peripheral device in response to detecting the selective decoupling; and activating the peripheral device independently of any other peripheral device coupled to at least one among the electronic host device and the peripheral device (column 3, line 19 – column 5, line 13).

Regarding claim 17, Nikum discloses the step of wearing at least one among the at least one peripheral device and the electronic host device on a user (since they are portable computer, cellular phone, and pager) (column 3, lines 19-34).

As to claim 18, Nikum discloses the step of automatically activating the peripheral device upon being decoupled from the electronic host device (column 3, line 19 – column 5, line 13).

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As to claim 20, Nikum discloses the step of operating any combination of peripheral devices concurrently and independently with their own separate relationship to the electronic host device (column 3, line 19 – column 5, line 13).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 6, 13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickum in view of Palermo et al. (US 2002/0132585).

Regarding claims 6, 13, and 19, Nickum discloses the electronic product, peripheral device, and method of claims 1, 10, and 16 above, respectively. Nickum does not disclose a peripheral device automatically senses the need for activating a new



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wireless link to the electronic host device using its own power source when selectively decoupled from the electronic host device. However, Palermo et al. (figure 1) disclose a peripheral device (headset 110) automatically senses the need for activating a new wireless link to the electronic host device using its own power source when selectively decoupled from the electronic host device (base station 120 and cellular phone 130) (paragraphs [0148] and [0156]). Therefore, it would have been obvious to adapt the teaching of Palermo et al. for automatically senses the need for activating a new wireless link to the electronic host device using its own power source when selectively decoupled from the electronic host device to the electronic product, peripheral device, and method of Nickum in order to simplify the activation of the peripheral device as suggested by Palermo et al. (paragraph [0148]).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

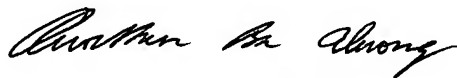
### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quochien B Vuong whose telephone number is (571) 272-7902. The examiner can normally be reached on M-F 9:30-18:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**QUOCHIEN B. VUONG**  
**PRIMARY EXAMINER**

Quochien b. Vuong  
May, 25, 2006.